

Remarks

The Examiner has made a restriction requirement between Group I (Claims 1-13 and 19-20), Group II (Claims 14-17), and Group III (Claims 24-29). Applicants confirm the election, with traverse, of the claims of Group I. Applicants believe that the claims of Group II, which claim methods of using the compounds of Group I, should be examined with Group I. The Examiner cites the MPEP section 806.05(h) as authority for restriction between Groups I and II because "the product as claimed can be used in a materially different process." The complete wording of the relevant portion of the MPEP is product claims may be restricted from claims to processes of using those compounds when "(A) the process of using as claimed can be practiced with another materially different product, or (B) the product as claimed can be used in a materially different process. In other words, a restriction between a product and a process of using that product may be proper if the claimed product can be used in a process materially different from the claimed process." The Examiner cites only the different diseases claimed in Claim 16 as evidence that the product of group I "can be used in a materially different process." The Examiner has not cited any uses for the product other than the claimed uses. Therefore, restriction is not proper and Groups I and II should be joined. Therefore, Applicants request that the restriction between Groups I and II be reconsidered and withdrawn.

The Examiner has also asked for an election of species and Applicants have elected the species of Claim 13. The Examiner then asserts that this election "has resulted in the following the generic concept". The Examiner now appears to have created a new chemical Markush claim of narrower scope than Applicants' Claim 1. Applicants have no idea what section of the MPEP or law permits the Examiner to narrow the scope of Claim 1. Claim 1 is a generic Markush-type claim which covers elected species Claim 13. There would appear to be no dispute that Claim 1 is a Markush group defining a group of chemical compounds. Restriction in Markush claims is covered by MPEP 803.02. This section of the MPEP requires an election of species followed by examination. An election has been made, and therefore examination must proceed. In addition, MPEP 803.02 further requires that if the elected species is found patentable, "the search of the Markush-type claim will be extended." The elected species has been found patentable. Applicants request that, as required by MPEP 803.02, examination begin.

Instead, the Examiner objects to Claims 1-13 and 19-20 and asserts that the "claims must be amended to exclude non-elected subject matter." Claims 1-13 and 19-20 do not contain "non-elected subject matter." Indeed, Claims 1-13 and 19-20 are the elected subject matter. On page 2 of the current Office Action the Examiner required a restriction to one of the following:

- I. Claims 1-13 and 19-20 drawn to a compound and composition of formula (I), classified in class 548 with plethora of subclasses.
- II. Claims 14-17 drawn to a method of treating a disease or condition classified in class 514 with few subclasses.
- III. Claims 24-29 drawn to a process of preparing a compound of formula (I), classified in class 548 with few subclasses."

In summary, the Examiner has made a restriction requirement between Groups I, II, and III. Applicants have elected Group I which the Examiner defined as "Claims 1-13 and 19-20 drawn to a compound and composition of formula (I)". The Examiner has also required an election of species. Applicants have elected the species of Claim 13. The Examiner has determined that the species of Claim 13 is allowable. Therefore, as required by MPEP 803.02, examination of the elected claims must continue. Instead, the Examiner objects to Claims 1-13 and 19-20 as containing "non-elected subject matter". As provided for under MPEP 821, Applicants traverse the Examiner's holding that Claims 1-13 and 19-20 contain non-elected subject matter. Contrary to the Examiner's assertion, Claims 1-13 and 19-20 are the elected subject matter. Therefore, as also directed by MPEP 821, "if the examiner adheres to his or her position after such traverse, he or she should reject the claims." Applicants note that once the Examiner rejects the claims as directed by MPEP 821, the propriety of this holding is appealable.

Respectfully submitted,

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